

REMARKS

The rejection of Claims 4 and 6-28 under 35 U.S.C. § 112, second paragraph, is respectfully traversed. Claim 4 is drawn to a compounding agent for an antifouling paint, comprising one or more substances selected from a Markush group of substances, as recited therein. There is no indefiniteness in the use of the term "comprising". In addition, since a metal salt in and of itself could be characterized as a derivative of the cyclic carboxylic acid, Applicants' intent with regard to the Markush group in Claim 4 is to cover the carboxylic acid derivative *per se*, as well as non-metal salt derivatives of the carboxylic acid, metal salt (derivatives) of the cyclic carboxylic acid, and metal salts of derivatives of the cyclic carboxylic acid. In other words, Applicants distinguish metal salt derivatives from non-metal salt derivatives in this claim so as to distinguish them from a metal salt derivative of a non-metal salt derivative of the cyclic carboxylic acid. Thus, for example, a metal salt of the cyclic carboxylic acid could be, for example, a compound having formula [V] wherein R⁷ or R⁸ was replaced with a metal salt moiety; the other of R⁷ and R⁸ being hydrogen. A non-metal salt derivative of the compound of formula [V] could be where one of R⁷ and R⁸ is a hydrocarbon group; the other of R⁷ and R⁸ being hydrogen. A metal salt of a derivative of the compound of formula [V] could be where one of R⁷ and R⁸ is a hydrocarbon group, and the other is a metal salt moiety.

Thus, contrary to the finding by the Examiner, the claims do not both exclude and include a metal salt of a derivative of the cyclic carboxylic acid in the same claim.

For all the above reasons, it is respectfully requested that this rejection be withdrawn.

The objection to Claim 5 is now moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that the objection be withdrawn.

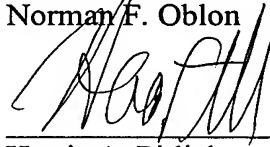
Application No. 10/581,039
Reply to Office Action of June 22, 2007

All of the presently-pending claims in this application are now believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Norman F. Oblon



Harris A. Pitlick

Registration No. 38,779

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 03/06)

NFO:HAP\la